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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,838	03/23/2001	Peggy M. Stumer	2001P05291US	6909

7590

09/09/2003

Siemens Corporation  
Attn: Elsa keller, Legal Administrator  
Intellectual Property Department  
186 Wood Avenue South  
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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 09/09/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

GA

# Office Action Summary

Application No.  
09/816,838

Applicant(s)  
Peggy M. Stumer et al.

Examiner  
Melur. Ramakrishnaiah

Art Unit  
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 16, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

Art Unit: 2643

1. The Office action is in response to applicant's response dated 6-19-2003.
2. Since applicants have not addressed the issue of nonstatutory double patenting rejection, the double patenting rejection is maintained.

***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2643

4. Claims 1-18, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending application No 09/816823, claims 1-20 of copending Application No. 09/816,843, and claims 1-20 of copending Application No 09/816,830. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims directed to the same invention of processing emergency call made from CPE.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 10-12, are rejected under 35 U.S.C 102(b) as being anticipated by Hoskinson et al. (US PAT: 5,339,351, hereinafter Hoskinson).

Hoskinson discloses a method and apparatus for transmitting an emergency location number (ELIN) and/or callback number from a customer premises equipment (CPE) to public safety answering point (PSAP) after emergency call goes on -hook, the method comprising the steps of: upon initiation of emergency call, storing ELIN/and or callback number in a buffer (not

Art Unit: 2643

shown but inherently inside location response module 39, fig. 2), upon detecting an on-hook event, transmitting the ELIN/or callback number from the buffer to PSAP ( in response to a callback from the PSAP upon detecting an on-hook event). Hoskinson also teaches disconnecting after transmitting information to the PSAP and prior to the transmitting step, initiating a timer (figs. 2, 4, col. 8 lines 5 to col. 9 lines 25).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-8, 13-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoskinson in view of the admitted prior (page 3 first full paragraph applicant's specification).

Hoskinson differs from the claimed invention on not disclosing the use of ISDN SETUP message, ASIG ISDN SETUP message signaling, ISDN DISconnect message, DTMF signal, CAMA trunk type signaling for transmitting information as claimed. However, the use of such signaling types are old and well known in the art depending on the type of trunk circuit used for as is illustrated in the admitted prior art. Thus, it would have been expediently obvious to one of ordinary skill in the art at the time invention was made to modify Hoskinson's system to use

Art Unit: 2643

various signaling types dependent on the type of trunk circuit used thereby accommodating various existing types trunk circuits.

9. Applicant's arguments filed 6-16-2003 have been fully considered but they are not persuasive.

Applicant's remarks in the first paragraph of page 6 is noted however, this is not persuasive sine applicant is reading limitations into the claims. The claims does not require any signaling messages as alleged.

Applicant's remarks regarding Hoskinson on page 6 of paragraph 1 is noted and are not persuasive. Hoskinson clearly teaches the sending location identification information by reading location identification from location storage (41, fig. 2) and location response unit sending this information to the emergency response center in response to request for this information from emergency response center (23, fig. 1, col. 6 lines 46-65). For sending the location information, emergency response block (39, fig. 2) reads this information from the location storage block (41, fig. 2) and this inherently implies that this information needs to be buffered in (39) in order to transmit this information. Thus, buffering location information in response block 39 is inherent.

Applicant's remarks regarding Hoskinson in the last paragraph of page 6 is noted and are not persuasive. Applicant's claims are broad enough not to preclude the possibility as disclosed by Hoskinson, in which after detecting the on-hook condition transmitting to the emergency call center ELIN information in response to a callback from the emergency call center.

Art Unit: 2643

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on Monday to Friday from 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Art Unit: 2643

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

  
Melur. Ramakrishnaiah

PRIMARY EXAMINER

Art Unit 2643.